

Remarks

The following numbered paragraphs are provided to respond to the similarly numbered paragraphs in the Office Action (e.g., paragraph "1" below corresponds to paragraph 1 in the Office Action).

1-2. As an initial matter, Applicant strongly disagrees with the Examiner regarding the scope of the pending claims and believes that many of the pending claims are generic and cover more than just the Figs. 59-63 embodiment. To this end, Applicant believes that the pending claims at the very least cover the embodiments illustrated in Figs. 26-27, 31-34 and 59-63. Why Applicant still believes that the pending claims are more generic than the Examiner has indicated is described in the section of this Office Action response labeled 4-6 that follows.

3. With respect to the claims withdrawn by the Examiner, because Yarin is not a proper prior art reference as explained in the following section of this Office Action response, at least claims 1, 22 and 107 should be allowed over the art currently cited and therefore there may still be an allowable generic claim to cover the claims withdrawn by the Examiner. If the Examiner agrees that Yarin is not a prior art reference to at least some of the claims as discussed below, Applicant requests that the Examiner reinstate the withdrawn claims that are affected by the different status of Yarin.

4-6. The Office Action rejected each of claims 1-11, 15, 17, 22-29,33,36 and 107-108 as anticipated by Yarin. Applicant traverses this rejection as Yarin is not prior art against the pending claims.

First, with respect to the scope of the claims, while the claims that are still pending in this case indeed read on the species described and shown in Fig. 59 and the associated test in the present specification, Applicant again notes that many of the pending claims are generic to other embodiments in the specification. In this regard, for instance, claim 1 also clearly reads on, among others, the species illustrated in Figs. 26-27 and in Figs. 31-34. More specifically, the species in Figs. 26-27 includes a container 800 for holding doses of medication where the container

includes memory devices 60 that contain specifying information useable to determine a prescribed dosing regimen, sensors 115 that define sensing areas and that receive specifying information when the memory devices are within the sensing areas and a processor wherein the processor receives and uses the specifying information to identify prescribed dosing regimen information and performs at least one health safety function as a function of the prescribed regimen information. Similarly, the species in Figs. 31-33 includes a container 900 for holding doses of medication where the container includes memory devices 960 that contain specifying information useable to determine a prescribed dosing regimen, sensors 940 that define sensing areas and that receive specifying information when the memory devices are within the sensing areas and a processor wherein the processor receives and uses the specifying information to identify prescribed dosing regimen information and performs at least one health safety function as a function of the prescribed regimen information. Clearly RF memory devices and RF sensors are contemplated by the present specification.

Virtually all of the other pending claims also read on one or both of the embodiments illustrated in Figs. 26 and 31 and therefore Applicant believes that the pending claims are generic to more than just the embodiment illustrated in Figs. 59 through 63.

Second, whether or not the pending claims are generic to the embodiments of Figs. 26 and/or 31 and/or any other embodiments corresponding to Figures 1-35 is important because each of those embodiments was first described in the parent patent (hereinafter "the parent patent specification" or "the parent specification") to the present application, US patent number 6,259,654. The parent patent was filed more than one year prior to Yarin and therefore Yarin is not prior art to any concepts first disclosed in the parent patent specification. Thus, where claim 1 covers each of the embodiments illustrated in Figs. 26 and 31 which were initially disclosed in the parent application, Yarin cannot properly be cited as prior art against claim 1. Claim 1 covers each of the embodiments illustrated in Figs. 26 and 31. With respect to using RF memory devices and sensors, the last paragraph in the parent patent specification teaches that RF devices may be employed in any of the disclosed embodiments.

With respect to claim 2, the claim 2 limitations are disclosed in the parent patent specification at col. 29, lines 30-52 in the context of either of the embodiments of Figs. 26 or 31.

With respect to claim 3, the claim 3 limitations are disclosed in Fig. 33 where a sensor area is located adjacent a sensor surface of sensors 940.

With respect to claim 4, the last paragraph in the parent patent specification teaches that either of the lids 810, 910 in Figs. 26 or 31, respectively, could be replaced with a "tray". Yarin uses the term tray in the normal way to refer to a generally flat and planar member having a top generally horizontal surface on which items can be supported. Yarin's tray is component 12 in Figs. 3, 11 and 13. Applicant used the term "tray" in the same way that Yarin used that term. Where a tray is swapped for one of the lids in Figs. 26 or 31, the tray necessarily includes a horizontal surface for supporting medicant holders (e.g., vials) thereon. Where RF devices are employed, RF devices necessarily have to be within a sensing area in order for information to be obtained therefrom. Thus, the claim 4 limitations are taught by the combination of either of Figs. 26 or 31 with the last paragraph of the parent patent specification.

With respect to claim 5, Fig. 18 of the parent specification teaches a medicant holder including a memory device 460 on a bottom surface. Where the medicant holder of Fig. 18 is used with a tray including a sensor proximate the tray surface, memory device 460 would face downwardly and hence the limitations of claim 5 are taught in the parent specification.

With respect to claim 6, each of lids 810 and 910 includes a sensor 115 and 940 embedded therein (see Figs. 27 and 33, respectively). Where a tray is substituted for a lid as suggested by the last paragraph of the parent specification, the sensors would be embedded in the tray structure and hence within the planar tray member.

With respect to claim 7, the embodiment of Figs. 31-33 includes a sensing surface facing cassette 950 where a plurality of sensors 940 are mounted flush with the sensing surface. As best illustrated in Fig. 33, the sensors are distinguishable from other portions of the sensor surface (i.e., sensor 940 is distinguishable from the section of the sensor surface thereabove and, while not illustrated, would also be

distinguishable from the portion of the sensor surface between adjacent sensors 940 – there is a separate sensor for each of slots 920 (see Fig. 32)). The visually distinguishable surface of the sensor is an aligner as required by claim 7 and hence the limitations of claim 7 are taught in the parent patent specification.

In addition, with respect to claim 7, slots 920 (see again Fig. 32) also form aligners that are aligned with the sensors 940 and that distinguish one sensing section from the next. Thus, for this reason also claim 7 limitations are taught by the parent specification.

With respect to claim 8, the visually distinguishable surface of the sensor is indicia as required by claim 8. In addition, the slots 920 are also indicia as required by this claim. Hence the limitations of claim 8 are taught in the parent patent specification.

With respect to claim 9, the downward facing surface of cassette 950 in Figs. 31-33 has a first shape and slot 920 has a second shape and the first and second shapes are essentially identical (e.g., the shape of the downward surface of cassette 950 is receivable within the space formed by slot 920). Thus, the limitations of claim 9 are taught by the parent specification.

With respect to claim 10, the embodiment of Fig. 26 teaches vials having bottom surfaces. Where a tray is substituted for a lid as taught by the parent specification, the bottom surface of the vial would be a downward surface.

With respect to claim 11, each of the embodiments of Figs. 26 and 31 teach integral sensors and communication devices (e.g., display screens). In fact, the embodiment of Fig. 59 teaches a display screen that is not integral with a sensor pad linked thereto.

With respect to claim 15, Fig. 26 of the parent specification teaches that many vials, each including a memory device, can be received in sensing ports wherein when more than one vial is received in the ports, the information from each memory device is obtained. Similarly claim 15 reads on the embodiment of Fig. 31 that includes multiple sensors for obtaining information from multiple memory devices. Thus, claim 15 clearly reads on the embodiments of Figs. 26 and 31 which are supported by the parent specification.

With respect to claim 17, each of the embodiments of Figs. 26 and 31 includes a visual display 132, 812. Thus the limitations of claim 17 were first described in the parent specification.

With respect to claim 22, claim 22 is similar to claim 1 except that a sensing area associated with a sensor is capable of receiving at least two specifying devices at the same time. Here, Applicant notes that while the sensing area may receive two specifying devices at the same time, the sensing area may include first and second separate sensing areas. To this end see claim 25 that further limits claim 22 by requiring that the sensing area include first and second separate sensing areas for receiving information from separate specifying devices. Turning to the parent specification, the embodiment of Figs. 31-33 teaches a sensing area adjacent sensors 940 for receiving at least two specifying devices for obtaining information therefrom. Again, the processor functions required by claim 22 are taught in the patent specification at col. 29, lines 30-52.

With respect to claim 23, display 812 in Figs. 31 and 33 is a communication device that is capable of indicating any of the medicant holders.

With respect to claim 24, the timing device and processor functions claimed are taught at col. 29, lines 30-52 of the parent specification.

With respect to claim 25, the embodiment of Figs. 31-33 teaches a separate sensor 940 for each of the slots 920 and hence teaches at least first and second separate sensing areas for receiving specifying information.

With respect to claim 26, the embodiment of Figs. 31-33 teaches a visual a warning indicator (e.g., see the arrow on screen 812) adjacent each sensor 940 (i.e., on the opposite side of wall 918) that is provided to indicate that a medication should be taken.

With respect to claim 27, the embodiment of Figs. 31-33 teaches a medicant holders 950 that have downwardly facing external surfaces and lateral surfaces where memory devices 960 are mounted to the lateral surfaces. This embodiment also teaches aligners 920 for each of the sensing sections or sensors 940 that distinguish the sensing sections from the non-sensing sections of the surface 918 that is flush with the sensors. This embodiment also teaches that memory devices should be proximate sensors used to obtain information therefrom. Moreover, the

parent patent specification teaches that a tray may be substituted for the lid 910 (see again the last paragraph in the parent specification). Where a tray having a substantially flat top surface is substituted for a lid including a sensor embedded in the lid, the sensor surface on the tray would be horizontal.

With respect to claim 28, slots 920 are indicia. In addition, the different appearances of the sensors 940 and the other sections of surface 918 are akin to indicia.

With respect to claim 29, the downward facing surface of cassette 950 in Figs. 31-33 has a first shape and slot 920 has a second shape and the first and second shapes are essentially identical (e.g., the shape of the downward surface of cassette 950 is receivable within the space formed by slot 920). Thus, the limitations of claim 29 are taught by the parent specification.

With respect to claim 33, where RF memory devices and sensors are employed as taught in the last paragraph of the parent specification, RF sensors typically scan periodically as opposed to scanning continuously. Thus, the parent specification teaches the limitations of claim 33.

With respect to claim 36, each of the embodiments of Figs. 26 and 31 includes a visual display 132, 812. Thus the limitations of claim 36 were first described in the parent specification.

With respect to claim 107, claim 107 is a method claim that is similar to claim 22. Turning to the parent specification, the embodiment of Figs. 31-33 teaches a sensing area adjacent sensors 940 for receiving information from at least two specifying devices. Again, the processor functions required by claim 22 are taught in the patent specification at col. 29, lines 30-52.

With respect to claim 108, the embodiment of Figs. 31-33 teaches a separate sensor 940 for each of the slots 920 and hence teaches at least first and second separate sensing areas for receiving specifying information from separate medicant holders. In addition, this embodiment teaches arrows (see arrow on screen 812 in Fig. 31) corresponding to each of the separate sensors for indicating when an associated medicant should be consumed.

Thus, while the pending claims indeed cover the species described with respect to Figs. 59-63, the pending claims are also generic to the species associated

with each of Figs. 26 and/or 31 and related claims and specification text. Because each of the embodiments associated with Figs. 26 and 31 was first described in the parent patent specification that filed more than one year before Yarin, Yarin is not prior art to the pending claims.

Even if the Examiner reads the pending claims in a way in which the claims do not generically cover the Fig. 26 and Fig. 31 embodiments, Applicant believes that much of what is taught in the Fig. 59 embodiment is also taught in the parent application and therefore that the pending claims, even if narrowly construed to cover only the Fig. 59 embodiment, would be supported by the parent specification. To this end, as discussed above, the last paragraph in the detailed description section of the parent patent specification states that the caps, covers or lids in the configurations described in the specification could be replaced by a tray. Where either of the lids in Figs. 26 or 31 is replaced by a tray, the resulting embodiment would have an appearance very similar to that in Fig. 59 of the continuing application and would necessarily have many of the limitations taught or suggested by the Fig. 59 embodiment. For instance, in light of the teachings throughout the parent specification that memory devices should be placed on medicant holders at locations where the memory devices will be proximate sensors provided to read the memory devices, where a sensor is mounted within a tray and the medicant holders include vials, the vial would be supported on the tray via its bottom surface and the memory device on the medicant holder would be positioned on the bottom surface of the vial.

Applicant has introduced no new matter in making the above amendments and antecedent basis exists in the specification and claims as originally filed for each amendment. In view of the above amendments and remarks, Applicant believes claims 1-11, 15, 17, 22-29, 33, 36 and 107-108 of the present application recite patentable subject matter and allowance of the same is requested. In addition, Applicant believes that at least some of the originally filed claims in this application are generic to several of the embodiments and that at least some of those generic claims are allowable over the art of record as at least some of the species covered by the generic claims are supported by the parent specification that predates Yarin. Here, Applicant requests that if the Examiner determines that at least some of the


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claims are generic and allowable over the art considered by the Examiner, that the Examiner reinstate any withdrawn claims that are covered by the generic claims. No fee in addition to the fees already authorized in this and accompanying documentation is believed to be required to enter this amendment, however, if an additional fee is required, please charge Deposit Account No. 17-0055 in the amount of the fee.

Respectfully submitted,

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